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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/577,223

07/26/2006

Hans-Peter Brack

5026-1001

3418

466

7590

05/18/2009

YOUNG & THOMPSON

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EXAMINER

MICALI, JOSEPH

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

05/18/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/577,223	<b>Applicant(s)</b> BRACK ET AL.	
	<b>Examiner</b> Joseph V. Micali	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/26/06</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Status of Application*

Claims 13-28 are pending and presented for examination on the merit, as claims 1-12 have been cancelled.

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Claim Rejections - 35 USC § 112*

2. **Claims 15-20, 23-24, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

3. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, see applicant's usage of the term

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“preferably” in the aforementioned claims, which renders the limitation that follows as the narrower statement of the range/limitation, with the broad range/limitation being presented before the “preferably”.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**5. Claims 13, 21-22, and 25-27 rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 4,605,685 by Momose et al.**

With respect to claim 13, Momose discloses a method for preparing a membrane to be assembled in a membrane electrode assembly, comprising the step of swelling an ion-conducting membrane in a liquid containing at least one solvent by controlling the content of solvent in the ion-conducting membrane (**column 5, lines 35-50**).

With respect to claim 21, Momose discloses a method comprising the steps of providing a membrane in a pre-swollen state, coating the membrane on both sides with an electrode layer to form a sandwich and hot-pressing the sandwich (**column 5, line 35 – column 6, line 12**).

With respect to claim 22, Momose discloses a catalytic active layer disposed between the electrode layer and the membrane (**column 5, line 66 – column 6, line 12**).

With respect to claim 25, Momose discloses a catalytic active layer comprising ruthenium (**column 5, line 67-68**).

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With respect to claim 26, Momose discloses the production of such a membrane electrode assembly (**column 5, line 35 – column 6, line 12**).

With respect to claim 27, Momose discloses a membrane having a thickness in the range of 100 microns (**column 5, line 35**).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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**9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,605,685 by Momose et al.**

With respect to claim 17, Momose discloses a method characterized in that prior to the swelling step, the membrane is treated in a strong acid solution and then rinsed with water (**column 7, lines 38-45**). Though Momose teaches these steps, Momose does not specify the time period for treating with a strong acid solution. However, **MPEP 2144.05 [R-5]** states that, “Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. ‘[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.’” In this case, the general conditions of the claim are set by the prior art of Momose i.e. the treatment of the membrane in a strong acid solution, and thus, it would have been obvious to discover an optimum time period duration for such a treatment stage.

**10. Claims 14-16 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,605,685 by Momose et al, in view of US Patent No. 5,656,386 by Scherer et al.**

With respect to claim 14, Momose is silent as to the membrane being a radiation grafted membrane.

Scherer is drawn to an electrochemical cell, such as a fuel cell. Specifically, Scherer teaches that the membrane between electrodes of the cell is a radiation grafted membrane (**abstract, and column 4, line 27 – column 5, line 5**).

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At the time of invention it would have been obvious to a person of ordinary skill in the art to perform the process of Momose including employment of a radiation grafted membrane, in view of the teaching of Scherer. The suggestion or motivation for doing so would have been to produce a membrane with long-term stability (**Scherer, column 3, lines 17-28**).

With respect to claim 15, Scherer teaches a graft level ranging from 10-40% (**Examples 1-15**).

With respect to claims 16 and 19, Scherer teaches a crosslinker monomer, such as divinylbenzene, in the grafting solution at around 10-17% as relative to styrene (**Examples 9 and 14**).

With respect to claim 18, Scherer teaches the membrane being coated, specifically impregnated, with an ionically conducting polymeric phase, such as Nafion® (**column 3, lines 40-45, and Example 20**).

With respect to claim 20, Momose discloses a method characterized in that prior to the swelling step, the membrane is treated in a strong acid solution and then rinsed with water (**column 7, lines 38-45**). Though Momose teaches these steps, Momose does not specify the time period for treating with a strong acid solution. However, **MPEP 2144.05 [R-5]** states that, “Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. ‘[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.’” In this case, the general conditions of the claim are set by the prior art of

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Momose i.e. the treatment of the membrane in a strong acid solution, and thus, it would have been obvious to discover an optimum time period duration for such a treatment stage.

**11. Claims 23-24 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,605,685 by Momose et al, in view of US Patent Pub. No. 2004/0115499 by Tani et al.**

With respect to claims 23 and 28, Momose is silent on the electrode layer being selected from carbon cloth, carbon paper, or carbon felt.

Tani is drawn to a method for producing membrane-electrode structures. Specifically, Tani teaches the use of carbon paper being an electrode layer applied in the form of a hydrophilic slurry, which is then hot pressed to produce a membrane-electrode structure (**paragraphs 0072-0073**).

At the time of invention it would have been obvious to a person of ordinary skill in the art to perform the process of Momose including employment of carbon paper, in view of the teaching of Tani. The suggestion or motivation for doing so would have been to supply a carbon substrate for use as an electrode layer (**Tani, paragraphs 0070 and 0072-0073**).

With respect to claim 24, Tani teaches hot pressing conditions being at a temperature of 80-140° C, a pressure of 1-5 MPa, and a duration of 2-10 minutes (or 120-600 seconds) (**paragraph 0073**). MPEP 2144.05 [R-5] states that, “In the case where the claimed ranges ‘overlap or lie inside ranges disclosed by the prior art’ a *prima facie* case of obviousness exists.”

### ***Conclusion***

**12. Claims 13-28 are rejected.**



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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph V. Micali whose telephone number is (571) 270-5906.

The examiner can normally be reached on Monday through Friday, 7:30am to 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry A. Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joseph V Micali/  
Examiner, Art Unit 1793

/Michael A Marcheschi/  
Primary Examiner, Art Unit 1793